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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER, and WILL GARDENSWARTZ

Appeal 2010-000062
Application 08/873,974
Technology Center 3600

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal from the non-final rejection of claims 50-89. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to systems and methods for delivering incentives and related information to consumers via a computer network that links the consumers to network sites provided by product retailers and by product manufacturers (Spec. 1:6-10). Claim 50, reproduced below, is further illustrative of the claimed subject matter.

> 50. A system for distributing product incentives to consumers over a communication network, comprising:
>
> a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;
>
> at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and
>
> a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,
>
> wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

Claims 50-51, 54-58, 60-61, 64-68, 70-71, 74-78, 80-81, and 84-88 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jovicic (US 5,855,007, issued Dec. 29, 1988); claims 52, 62, 72, and 82 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jovicic in view of Perkowski (US 6,064,979, issued May 16, 2000); claims 53, 63, 73, and 83 stand

rejected under 35 U.S.C. § 103(a) as unpatentable over Jovicic in view of Perkowski and Smolen; and claims 59, 69, 79, and 89 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jovicic in view of Smolen (US 5,915,243, issued Jun. 22, 1999).

We AFFIRM-IN-PART.

ISSUES[2]

Did the Examiner err in asserting that Jovicic renders obvious the subject matter of independent claims 50, 60, 70, and 80?

Did the Examiner err in asserting that a combination of Jovicic and Perkowski renders obvious the subject matter of dependent claims 52, 54-56, 62, 64-66, 72, 74-76, 82, and 84-86?

Did the Examiner err in asserting that a combination of Jovicic, Perkowski, and Smolen renders obvious the subject matter of dependent claims 53, 63, 73, and 83?

FINDINGS OF FACT

We adopt the Examiner's Findings of Fact, with respect to the portions of Jovicic, Perkowski, and Smolen cited by the Examiner, as set forth on pages 30-39 of the Examiner's Answer.

[2] Other than their dependence from respective allowable independent claims 50, 60, 70, and 80, Appellants did not separately contest the rejections of dependent claims 51, 61, 71, and 81.

ANALYSIS

Independent Claims 50, 60, 70, and 80

We are not persuaded that the Examiner erred in asserting Jovicic renders obvious the subject matter of independent claims 50, 60, 70, and 80 (App. Br. 16-28; Reply Br. 3-6). Appellants have chosen independent claim 60 as representative (App. Br. 16). We will do the same.

Appellants assert that Jovicic does not disclose "coupling a consumer computer to one of said manufacturer network site and retailer network site via said communication network," as recited in independent claim 60, because user computer 102 is not coupled to either redemption center 142 and ICNC 134 (App. Br. 21-24; Reply Br. 4, 6). However, Fig. 1 of Jovicic discloses that user computer 102 is coupled to both redemption center 142 and ICNC 134 via internet public computer network 122 and internet coupon server 124 under a broadest reasonable interpretation of "coupling." *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). While Appellants may have intended the coupling to involve a more direct connection between user computer 102, redemption center 142, and ICNC 134, such as an aspect is not set forth in the claims. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005).

Appellants assert that Jovicic does not disclose "transmitting from said cooperative network site at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site," as recited in independent claim 60, because ICNC 134, and not the retailer, provides the coupon information to internet coupon server 124 (App. Br. 24-

25). However, Jovicic discloses that "[e]ach ICNC 134 is the owner of one particular category of coupons, for example a 'Ben & Jerry's Inc.' coupon category," which is a retailer under a broadest reasonable interpretation. (Jovicic, col. 6, ll. 24-26). *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364.

Appellants also assert that since internet coupon server 124 and ICNC 134 of Jovicic are a combined unit, only one network site is disclosed, and not two network sites, one for the cooperative network and one for the manufacturer/retailer network, as set forth in independent claim 60 (App. Br. 25-26; Reply Br. 5). However, not only are internet coupon server 124 and ICNC 134 disclosed as being separate units, but making something separable would have been obvious. *See In re Dulberg*, 289 F.2d 522, 523 (CCPA 1961).

Appellants further assert that internet coupon server 124, and not ICNC 134, receives the consumer request (App. Br. 26-27; Reply Br. 4-5). As set forth by the Examiner, internet coupon server 124 and ICNC 134 can be considered a single unit (Ex. Ans. 30-33). In such a case, both internet coupon server 124 and ICNC 134 would receive the consumer request, and since independent claim 60 does not specify that internet coupon server 124 cannot receive the consumer request, the aspect is met by Jovicic. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231. Moreover, Jovicic discloses that ICNC 134 receives a notification from internet coupon server 124 when internet coupon server 124 sends a coupon in response to a user request (col. 4, ll. 34-41), which is a part of the same continuous consumer request under a broadest reasonable interpretation. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364.

Dependent Claims 52, 54-56, 62, 64-66, 72, 74-76, 82, and 84-86

We are persuaded that the Examiner erred in asserting a combination of Jovicic and Perkowski renders obvious the subject matter of dependent claims 52, 54-56, 62, 64-66, 72, 74-76, 82, and 84-86 (App. Br. 28-43, 45-50; Reply Br. 6-7). Appellants have chosen dependent claims 62 and 64-66 as representative (App. Br. 28-29, 32, 39, 45-46). We will do the same.

Appellants assert that Jovicic does not disclose "transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site," as recited in dependent claims 62 and 64-66, because Jovicic discloses sending a user's incentive selection data from internet coupon server 124 to ICNC 134, and not vice versa as set forth in the claims (App. Br. 30-31, 37-38, 41-42, 48-49). The Examiner has not responded to this assertion, and instead appears to equate ICNC 134 as being the equivalent of redemption center 142 (Ex. Ans. 7-10, 25, 29, 35-37, 39). However, redemption center 142 only sends data concerning redeemed coupons to internet coupon server 124, and not selected incentive data to be sent back to the consumer as recited in the claims[3]. Moreover, we agree with Appellants that Jovicic discloses that any

[3] Dependent claims 62 and 64-66 further recite "transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said manufacturer network site." *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (internal citations omitted) ("[q]uite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms. To begin with, the context in which a term is used in the asserted claim can be highly instructive"); *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (the context of the surrounding words of the claim must be considered in determining the ordinary and customary meaning of those terms).

incentive selection data either (1) flows from internet coupon server 124 to ICNC 134, or (2) flows to both internet coupon server 124 and ICNC 134 simultaneously, and not from ICNC 134 to internet coupon server 124 as set forth in the claims. Accordingly, we cannot sustain these rejections.

Due to their dependence from respective claims 56, 66, 76, and 86, we also do not sustain the rejections of claims 57-59, 67-69, 77-79, and 87-89.

Dependent Claims 53, 63, 73, and 83

We are persuaded that the Examiner erred in asserting a combination of Jovicic, Perkowski, and Smolen renders obvious the subject matter of dependent claims 53, 63, 73, and 83 (App. Br. 50-52). Appellants have chosen dependent claim 63 as representative (App. Br. 50-51). We will do the same.

Appellants assert that col. 4, ll. 64-67 of Smolen, cited by the Examiner, discloses a telephone area code and not a postal code (App. Br. 51). We agree. Accordingly, we cannot sustain this rejection.

DECISION

The Examiner's rejection of claims 50-51, 60-61, 70-71, and 80-81 is AFFIRMED.

The Examiner's rejection of claims 52-59, 62-69, 72-79, and 82-89 is REVERSED.

AFFIRMED-IN-PART

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